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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DHILLON, MANJOT K

ART UNIT

PAPER NUMBER

3714

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/805,007	Applicant(s) MATTICE ET AL.	
	Examiner Malina K. Dhillon	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-18 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/4/04, 9/19/05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7 are drawn to a method for determining an operating frequency of a touch screen unit, classified in class 345, subclass 179.
 - II. Claims 8-12 are drawn to a touch screen apparatus comprising a clock generator, classified in class 345, subclass 174.
 - III. Claim 13 is drawn to a method for facilitating game play via a gaming apparatus that includes a touch screen generating sinusoidal signals to determine operating frequency, classified in class 463, subclass 36.
 - IV. Claims 14-18 are drawn to an apparatus for facilitating game play via a gaming apparatus that includes a touch screen using a configurable clock generator to generate a clock signal, classified in class 463, subclass 16.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as using a clock generator to generate a clock signal. See MPEP § 806.05(d).

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2)

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that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a touch screen can be used in any type of device such as a PDA. The subcombination has separate utility such as being used specifically in a gaming device.

Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as using a clock generator to generate a clock signal in a gaming apparatus. See MPEP § 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as using a clock generator to generate a clock signal for a touch screen used in any device. See MPEP § 806.05(d).

Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the

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particulars of the subcombination as claimed because a touch screen can be used in any type of device such as a PDA. The subcombination has separate utility such as being used specifically in a gaming device.

Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as using a clock generator to generate a clock signal for a touch screen.

A telephone call was made to David P. Olynick on 9/7/07 to request an oral election to the above restriction requirement, and resulted in an election being made without traverse to examine Group IV.

Claim Objections

2. Claim 1 is objected to because of the following informalities: line 17 contains a period after the word "signals". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 14-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bertram et al. (US 6476798 B1).

Concerning claim 14, Bertram et al. teaches a gaming apparatus, comprising: a display unit; a value input device; a touch screen unit including **[column 2, lines 8-11]**; a configurable clock generator to generate a clock signal having a configurable clock frequency, the configurable clock generator having an oscillator **[column 5, lines 11-17]**, a phase locked loop coupled to the oscillator **[fig. 4]**, and a configurable frequency divider coupled to the phase locked loop **[fig. 6a]**; a sinusoid generator coupled to a

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plurality of electrodes of a touch screen **[column 4, lines 17-27]** and coupled to the configurable clock generator **[fig. 4]**, the first sinusoid generator adapted to generate a sinusoidal signal having a frequency based on the clock frequency **[column 5, lines 11-19]**; a plurality of sensors coupled to the plurality of electrodes to generate sensed signals indicative of signals flowing from each electrode of the plurality of electrodes **[column 4, lines 17-27]**; and a touch position calculator coupled to the plurality of sensors adapted to generate an estimate of a touch position based on the sensed signals **[column 8, lines 26-50]**.

Bertram et al. teaches a main controller operatively coupled to the display unit, the value input device, and the touch screen unit, the main controller comprising a main processor and a main memory operatively coupled to the main processor **[figs. 6a and 6b]**, the main controller being programmed to receive value input data via the value input device, the main controller being programmed to cause the display unit to generate a first game display relating to one of the following games: poker, blackjack, slots, keno or bingo **[column 2, lines 8-11]**. Bertram et al. teaches the main controller being programmed to receive player input data via the touch screen unit **[column 5, lines 20-34, fig. 6a and 6b]**, the main controller being programmed to determine a value payout associated with an outcome of the game **[column 2, lines 8-11]**. Using the touch screen with an electronic slot machine encompasses games such as: poker, blackjack, slots, keno, bingo or any other game which all would determine payout according to the game played. This is something that at the time of the applicant's invention was well known in the art.

Concerning claim 15, Bertram et al. teaches the main controller is further programmed generate the estimate of the touch position based on estimates of amplitudes of the sensed signals **[column 16, lines 18-51]**.

Concerning claim 16, Bertram et al. teaches the main controller is further programmed to control the configurable clock frequency of the configurable clock generator **[column 5, lines 11-34]**.

Concerning claim 17, Bertram et al. teaches the touch screen unit comprises a touch screen controller **[fig 5a., elements 106 a-d]** operatively coupled to the main controller **[fig. 4, element 446]**, the touch screen controller comprising a touch screen processor **[fig 4., element 450]** and a touch screen memory operatively coupled to the touch screen processor **[fig. 6a and 6b]**, the touch screen controller being programmed to generate the estimate of the touch position based on estimates of amplitudes of the sensed signals **[column 6, lines 18-51]**.

Concerning claim 18, Bertram et al. teaches the touch screen unit comprises a touch screen controller **[fig. 5a, elements 106 a-d]** operatively coupled to the configurable clock generator **[fig. 5b, element 441]**, and the main controller **[fig. 4, element 446]**, the touch screen controller comprising a touch screen processor and a touch screen memory operatively coupled to the touch screen processor **[fig. 6a and 6b]**, the touch screen controller being programmed to control the configurable clock frequency of the configurable clock generator **[column 5, lines 11-34]**.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ely et al. (US 6249234 B1): Position Detector
- Ely et al. (US 6888538 B2): Position Sensor
- Kim et al. (US 6043810): Digitizer Controller
- Rindal (US 5977961): Method and Apparatus for Amplitude Band Enabled Addressing Arrayed Elements
- D'Amico et al. (US 5956020): Touchscreen Controller with Pen and/or Finger Inputs

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malina K. Dhillon whose telephone number is (571) 270-1297. The examiner can normally be reached on Mon. - Thurs., 7 AM - 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Malina K. Dhillon
Examiner
Art Unit 3714

MRD

9/10/07


ROBERT E. PEZZUTO
SUPERVISORY PRIMARY EXAMINER